

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated August 11, 2003, indicated that claims 1-2, 4-11 and 13-14 stand rejected under 35 U.S.C. § 102(e) over *O'Neal et al.* (U.S. Patent No. 6,263,064); and claims 3, 12 and 15-22 stand rejected under 35 U.S.C. § 103(a) over the '064 reference in view of *Kishinsky et al.*

Applicant notes that no patent number was listed for the *Kishinsky* reference in connection with the statement of the Section 103(a) rejection; therefore, Applicant requests clarification and an opportunity to respond thereto in a non-final manner. For purposes of the remarks below, Applicant has assumed that the *Kishinsky* reference is U.S. Pat. No. 6,286,033.

Applicant respectfully traverses the Sections 102(e) and 103(a) rejections, both of which rely on the '064 reference, because the rejections fail to explain where the claimed limitations are taught in the '064 reference in a manner consistent with 35 U.S.C. §132. Without such explanation, Applicant is unable to ascertain where the Examiner is asserting any correspondence between the cited reference(s) and the claimed limitations and is thus unable to adequately respond to the rejections. In general, no such correspondence appears to exist because the '064 reference does not appear to teach or suggest limitations directed to IP telephony in the context of the present invention. For example, on page 2 of the Office Action, a general reference is made to column 2, lines 6-10 of Background the '064 reference for asserted teaching of all of the following limitations of independent claim 1 (from which claims 2-14 depend):

a user-programmable communications arrangement including a computer having a display, the arrangement comprising: a user interface; and a programmable controller, the user interface and the programmable controller being adapted to: provide user-selected IP telephony configuration information to a control center communicatively coupled to a plurality of IP telephony devices

However, column 2, lines 6-10 of the '064 reference only discusses "a telephony-centric network ... that connects the millions of telephony devices ... together."

In this regard, Applicant cannot ascertain which elements in the '064 reference are relied upon in the rejection of the above claim limitations. For instance, Applicant cannot ascertain which elements in the '064 reference are asserted to correspond to the user interface, the programmable controller, the control center or the plurality of IP telephony devices.

As another example from page 2 of the Office Action, reference is made to column 4, lines 8-20 and 30-37 and to column 11, lines 36-50 of the '064 reference for asserted teaching of all of the following limitations:

(a programmable controller being adapted to:) display a control interface for at least one of: user control of an IP telephony device, office telephone administration control of a plurality of telephony devices, and system administrator control of telephony system configuration; and the IP telephony configuration information being selected to control communications between, and to programmably configure, the control center and the plurality of IP telephony devices.

As with the above discussion relating to column 2 of the '064 reference, the Office Action fails to specifically point out which elements in the '064 reference are asserted to correspond to these claim limitations. In this regard, Applicant cannot ascertain which elements in the cited portions of columns 4 and 11 of the '064 reference apply to these limitations. For instance, the Office Action fails to indicate which elements of the '064 reference are asserted to be the IP telephony devices or the control center. Furthermore, no mention is made in these cited portions of the '064 reference to IP telephony devices.

The rejections of claims 2-14 are improper for the reasons discussed above in connection with the rejection of claim 1. The Office Action further failed to explain which elements in the '064 reference correspond to various limitations in the dependent claims. For instance, regarding the rejection of claim 2 on page 3 of the Office Action, the Examiner has not indicated, nor can Applicant ascertain, any display that announces an incoming call. Regarding the rejection of claim 4 on page 3 of the Office Action, the Examiner has not indicated where a display shows user control options with a call announce function (*i.e.*, for routing a currently active call). Regarding the rejection of claim 6, the Examiner has not indicated what portion of the '064 reference is a computer including an IP

telephony device. No mention of such a computer-telephony device with a display is made in these cited portions, and Applicant cannot find any mention of this subject matter upon brief review of the '064 reference. The rejections of the other dependent claims exhibit similar deficiencies.

In addition to the inadequacies of the rejections as discussed above in connection with independent claim 1 and claims that depend therefrom, limitations in independent claims 15 and 20, which are directed to similar subject matter, are also improper for similar reasons. For example, the rejections of claim 15 on page 7 and claim 20 on page 8 of the Office Action fail to point out which elements in the '064 reference are being asserted to correspond to each of the claimed limitations. The rejections of claims 16-19, which depend from claim 15, and claims 21-22, which depend from claim 20, are also improper for similar reasons.

In view of the above, Applicant is unable to understand the Sections 102(e) and 103(a) rejections in a manner as required in 35 U.S.C. §132 in order to judge the propriety of the rejection. Therefore, Applicant requests that the Sections 102 and 103 rejections be removed.

Applicant further traverses each of the Sections 102(e) and 103(a) rejections because they fail to present a *prima facie* case of correspondence between the claimed invention and the cited reference(s), considering the '064 reference alone or in combination with the *Kishinsky* ('033) reference. Specifically, the rejections do not show where the '064 reference teaches various ones of the claimed limitations as discussed above. In addition, the Office Action has failed to show how the '064 reference corresponds to IP telephony in a manner consistent with the claimed limitations of the present invention. For example, Applicant has briefly reviewed the '064 reference and has found no mention whatsoever of IP telephony devices as discussed in the context of the present invention and as claimed, for example, in independent claims 1, 15 and 20 as discussed above. Rather, the "telephony-centric network" (e.g., 129 in FIG. 1 of the '064 reference) appears to be limited to a public telephone network and makes no mention of IP telephony. As discussed, e.g., in column 4, lines 15-16 of the '064 reference, such a telephony-centric network, while apparently capable of digital and analog

communications, is limited to a voice telephone service and is separate from the data-centric network.

The Sections 102(e) and 103(a) rejections also fail to present a *prima facie* case of correspondence in connection with the dependent claims, as they relate to the independent claims discussed above and further in connection with the limitations in the dependent claims. For instance, regarding the rejection of claim 2, the cited portions of column 8 and 10 do not mention a display that announces an incoming call. As the '064 reference does not appear to address IP telephony, this type of call handling does not appear to relate to the '064 reference, in the cited portions thereof or elsewhere. For instance, the cited portions of columns 8 and 10 appear to limit voice communications to communications between a telephone controller and telephones using a telephony-centric network that is unrelated to any IP telephony communications. Moreover, it is unclear how any call-routing involves display of an incoming call, or where such display would take place; it appears that the main message server 202 cited in column 10 does not interactively route active calls and instead is programmed to automatically handle call functions.

Regarding the rejection of claim 4, the cited portions of the '064 reference do not teach or suggest the subject matter directed to interactive call management for active calls. For example, the cited portions of columns 11 and 12 appear to be directed to fixed settings such as call forwarding. No mention is made of subject matter directed to actively making selections for an incoming call via a display. Similarly, the rejection of claim 12 fails to show how active call functions directed to answering a telephone call, placing a telephone call on hold and other active call control features could be effected for active telephone calls in the '064 reference.

Regarding the rejection of claim 6, the cited portions of columns 2 and 9 make no mention of the computer including an IP telephony device. Not only is it unclear as to what element in the '064 reference the Examiner is asserting to be the computer as discussed above, it is further unclear how any computer in the '064 reference includes an IP telephony device as claimed in the present invention.

In view of the above, the Sections 102(e) and 103(a) rejections in the Office Action fail to establish *prima facie* correspondence between the cited reference(s) and the claimed limitations of the instant invention; therefore Applicant requests that the rejections be removed.

Applicant further traverses the Section 103(a) rejections because the rejections fail to set out a *prima facie* case of obviousness, which requires that the cited reference show teach or suggest every element of the claimed invention and that there be motivation to combine the references. In this instance, the Section 103(a) rejections fail to show correspondence between the cited references and all of the claimed limitations as discussed above. The Section 103(a) rejections also fail to meet the motivation requirement. Specifically, the rejections fail to cite evidence from the prior art that suggests the asserted modification of the primary '064 reference as indicated in relevant case law.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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